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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/248,524    02/09/99    SHAH

A    2870/72

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NEW YORK NY 10004

HM22/0925

EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

09/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/248,524

Applicant(s)

SHAH, AMIT R.

Examiner

Alysia Berman

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. Receipt is acknowledged of the response filed August 9, 2001. Claims 1-22 are pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "long-wearing" in claims 1, 10, 19 and 22 is a relative term which renders the claim indefinite. The term "long-wearing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5. Claims 1-4, 6-13 and 15-21 are indefinite because the independent claims recite, for example, acrylic acid derived polymer and acrylic acid ester derived copolymer. It is unclear what Applicant intends to encompass by the word "derived". The specification does not provide an exclusive definition of the derived polymers and copolymers. The metes and bounds of the claims cannot be determined.

6. Claims 3, 12 and 20 are indefinite because they claim a polymeric component that has an indefinite number of carbon atoms. Deletion of the word "about" would overcome this rejection.

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7. Clarification is requested as to what is encompassed by FD&C green no. 5 in claim 8. The Examiner was unable to find a reference defining or listing FD&C green no. 5. It is requested that Applicant provide a standardized reference defining FD&C green no. 5.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 6-13 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,324,506 A (506).

US '506 is directed to colored cosmetic compositions (title). The compositions comprise about 0.5-50 wt.% pigments (col. 2, lines 33-39 and claim 14) and can be in several different forms (col. 2, lines 40-46). For organic water-soluble pigments such as FD&C Blue No. 1, FD&C Red No. 40 and FD&C yellow No. 5, see column 2, line 49 to column 3, line 10 and claims 6-9. For acrylic, acrylate, and methacrylate polymers and copolymers, see column 3, line 23 to column 4, line 8 and claims 10-13. For additional inorganic pigments that can be incorporated into the compositions, see column 4, line 58 to column 5, line 8. US '506 discloses at column 5, lines 48-56 and in claim 18 that the compositions can be in the form of a liquid. Glosses, which are conventionally fluid, are disclosed at column 2, lines 40-46. For the method of combining the polymeric component with the organic water soluble pigment, see the examples at column 6, line

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14 to column 7, line 43. US '506 discloses liquid cosmetic compositions that comprise water soluble organic pigments, polymeric components and inorganic pigments as instantly claimed.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-14 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,324,506 (506) in combination with US 4,988,502 (502).

US '506 discloses all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not disclose ammonium acrylate as in instant claims 5, 14 and 22.

US '502 teaches mascara compositions that comprise ammonium acrylate copolymer as a film forming polymer (col. 3, lines 53-63). US '502 discloses at column 3, lines 64-66 that the film forming polymers do not produce sticky products.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '506 substituting the ammonium acrylate copolymer of US '502 for its film forming properties with the reasonable expectation of obtaining a non-sticky cosmetic composition.

12. Claims 1-4, 6-13 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,324,506 (506) in combination with US 4,761,277 (277).

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US '506 discloses all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. US '506 further discloses the compositions can be in the form of a mascara or other similar make-up composition (col. 2, lines 40-42). It does not disclose a flow-through cosmetic applicator (claims 15 and 17) or an eyeliner pen having a nib (claims 16 and 18). US '277 teaches at column 1, lines 12-21 that flow-through eyeliner pens having a nib are conventional in the art. US '277 discloses lip compositions that can be used in the same type of applicator pens as eyeliner compositions (col. 1, lines 35-50).

US '506 discloses liquid cosmetic compositions that comprise water soluble organic pigments, polymeric components and inorganic pigments as instantly claimed. The compositions are safe for use around the eyes as evidenced by the teachings of use as a mascara. Therefore, the compositions would also be safe and useful as eyeliner compositions. There is nothing in the instant claims to distinguish from the composition of US '506. Therefore, the composition of US '506 could be used as an eyeliner. US '277 discloses that eyeliner compositions are conventionally provided in flow-through pens having a nib.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the composition of US '506 as an eyeliner composition in a flow-through pen having a nib as taught by US '277.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.


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**Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
September 17, 2001

  
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SUPERVISORY PATENT EXAMINER  
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